Remarks/Arguments

A.   Pending Claims

Claims 1-11, 13-18 and 20-22 have been rejected. Claim 1 has been amended for clarification. Claims 1-11, 13-18, and 20-22 are pending.

B.   Information Disclosure Statement

The Office Action indicated that the IDS statement filed 27 October 2003 has been entered and considered.   The Office Action did not, however, indicate that the IDS statement filed June 17, 2004 had been entered and considered. The IDS statement filed June 17, 2004 (which includes references G1-G43, H1-H18, I1-I2, J1-J7, and K1 and electronic references 1-6) was submitted with the requisite fee pursuant to 37 C.F.R. §1.97. Applicant respectfully requests that the June 17, 2004 IDS statement be entered and the references thereon be considered and made of record.

C.   The Claims Are Not Obvious Over Borghesi In View of DeFrancesco Pursuant To 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 2, 6, 7, 9, 10, 12-14, 16, 17, and 19-21 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,950,169 to Borghesi et al. (hereinafter "Borghesi") in view of U.S. Patent No. 6,505,176 to DeFrancesco et al. (hereinafter "DeFrancesco"). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03. Applicant submits that the cited art, taken in

combination, does not appear to teach or suggest all of the claimed limitations of the cited art.

Claim 1 describes a combination of features including: "an insurance claim processing server comprising a first CPU and a first memory coupled to the first CPU, wherein the first memory stores a first set of program instructions which are executable by the first CPU to: estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction". Applicant respectfully submits that the cited art does not appear to disclose at least the above features of claim 1.

The Examiner states:

> Borghesi discloses a system for managing insurance claim processing comprising:
> (a) a communication server for insurance claim management comprising a processor coupled to memory, wherein the memory is embodied as a mass storage device and storing a program constructed using known software tools and languages, wherein the program is used for ... transmitting, from a remote computer, a predetermined amount of data related to calculating a total loss valuation to the server, wherein the predetermined amount of data is input by a user through a user interface, wherein the total loss valuation is then sent back to the remote computer...;

Applicant notes that the Examiner's description quoted above does not appear to describe the above-cited features of "an insurance claim processing server comprising a first CPU and a first memory coupled to the first CPU, wherein the first memory stores a first set of program instructions which are executable by the first CPU to: estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction". The Examiner appears to take the position that Borghesi's disclosure of a communication server (as recited, for example, in claims 1 and 5 of Borghesi) teaches or suggests an insurance claim processing server as recited in claim 1. Applicant respectfully disagrees with the Examiner's position. Borghesi states:

The system 28 preferably comprises computer terminals or networks at an insurance company home office 30, a local claims office 32 and an auditor 34. Each of these computers is in communication with a <u>communication server</u> 36 over a communication line 37 such as telephone lines or wireless communications facilities. The <u>communication server</u> 36 may be a specialized server dedicated to insurance claim management, such as the EZNET server provided by CCC Information Services, Inc., or a general wide area network provider such as America On Line (AOL). The server 36 preferably has a plurality of flexible <u>memory locations, or mailboxes, for storing insurance datafiles and communications</u>. Computers located at an appraiser 38, direct repair program (DRP) facility 40, or independent appraiser 42 are also in communication with the server 36 over a communication line. The computer of the home office 30 preferably holds the mastercopy of each insurance datafile unless the assigned appraiser 38, DRP shop 40 or independent appraiser 42 is working on the specific insurance claim assignment associated with a datafile.
(Borghesi, col. 5, line 55 to col. 6, line 5)

FIG. 3 of Borghesi discloses a "communication server" connected to various computers. Borghesi appears to teach or suggest a <u>communication</u> server for passing information among computers, such as computers located at an insurance company home office, local claims office, or appraiser. Borghesi does not appear to teach or suggest an <u>insurance claims processing server</u> comprising a memory storing a first set of program instructions executable <u>to estimate a value of</u> <u>an insurance claim</u> as a function of insurance claim assessment data and comprising <u>a sequence</u> <u>of insurance claim processing steps executable to complete an insurance claim transaction</u>. Instead, Borghesi appears to teach remote computers that can access a communication server. Some of the remote computers are used to collect and transmit information related to automobile insurance claims. Other of the remote computers (for example, the remote computers located at the insurance companies home) are used to perform functions related to the processing of the insurance claim. Borghesi does not appear to teach or suggest that this communication server is capable of performing insurance claim processing tasks.

The Examiner appears to rely on the statement in Borghesi that "communication server 36 may be a specialized server dedicated to claims management such as EZNET server provided by CCC Information Services, Inc., or a general wide area network provider such as America On Line" (Borghesi, col. 5, lines 58-62). The preceding statement in Borghesi appears simply to

teach that the <u>communication</u> server can be dedicated to insurance claims management, as contrasted with a general provider WAN provider such as America On Line that also communicates information unrelated to insurance claims. The statement does not appear to teach or suggest an insurance claims processing server that includes a memory storing program instructions comprising a sequence of insurance claim processing steps executable to complete an insurance claim transaction. Applicant notes that the federal trademark registration for the EZNET mark states that the EZNET mark is used "for electronic <u>communications network services</u> which <u>allow communication among</u> insurance claims offices, automobile repair facilities, automotive parts suppliers, car rental agencies, and other entites related to automotive collision repair services." See Trademark Electronic Search System (TESS) record for EZNET, Registration No. 2249451, attached hereto (emphasis added).

The Examiner cites language in claim 5 of Borghesi (Borghesi, col. 21, lines 30-35) and claim 29 of Borghesi (Borghesi, col. 23, lines 17-34). Neither of these claims, however, appears to teach or suggest teach or suggest an insurance claims processing server comprising a memory storing a first set of program instructions executable to estimate a value of an insurance claim as a function of insurance claim assessment data and a sequence of processing steps executable to complete an insurance claim transaction. Claim 5 of Borghesi states "transmitting a predetermined amount of data related to calculating a vehicle total loss valuation to the server, receiving the total loss valuation at the remote computer, and appending the total loss valuation to the datafile." (Borghesi, col. 21, lines 30-35). The Examiner apparently interprets this language as suggesting that the communication server estimates the value of an insurance claim. The language of claim 5 does not state that the communication server estimates the value of an insurance claim. Moreover, the detailed description and drawings in Borghesi do not appear to teach or suggest a communication server performing such a function. Instead, the detailed description appears to teach or suggest that the total loss valuation is received from a home office computer (Borghesi, col. 10, lines 6-11; col. 11, lines 33-35) or from a third party provider (Borghesi, col. 13, lines 45-57; col. 10, lines 26-28).

In addition, claim 1 of Borghesi, from which claim 5 depends, describes a method

comprising "building sections of the datafile at the remote computer using information accessed from an external source to the remote computer" (Borghesi, col. 21, lines 9-12) (emphasis added) and claim 5 describes "receiving the total loss valuation at the remote computer, and appending the total loss valuation to the datafile." (Borghesi, col. 21, lines 30-35) (emphasis added). Thus, even if claim 5 did suggest that the communication server estimates a value of an insurance claim, claim 5 does not appear to teach or suggest an insurance claims processing server comprising a memory storing a first set of program instructions comprising a sequence of insurance claim processing steps executable to complete an insurance claim transaction.

Claim 29 of Borghesi states:

29. A system for processing insurance claims comprising:
a remote computer for entering data related to an insured;
a wide area network capable of communicating with said remote computer;
a computer in communication with said wide area network;
an insurance claim datafile, generated at said remote computer, wherein the entire datafile is transferable between the remote computer and the computer, said datafile having inspection, repair estimate, total loss, and settlement information related to an automobile insurance claim; and
a user interface for managing insurance claim datafile processing pertaining to an insurance claim, said user interface allowing communication of input and output data, said user interface further comprising means for calculating and comparing repair and total loss values.
(Borghesi, col. 23, lines 17-34)

Claim 29 of Borghesi appears to teach or suggest an insurance claim datafile generated at a remote computer that is transferable from a remote computer to another computer over a wide area network, and a user interface comprising means for calculating repair and total loss values. Borghesi does not appear to teach or suggest an insurance claims processing server comprising a memory storing a first set of program instructions executable to estimate a value of an insurance claim as a function of insurance claim assessment data and comprising a sequence of processing steps executable to complete an insurance claim transaction.

Claim 1 describes a combination of features including: "wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to

complete an insurance claim transaction, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time." The Examiner notes that Borghesi "fails to expressly disclose" this feature of claim 1. Nonetheless, The Examiner states: "it would have been obvious to one of ordinary skill in the art to combine the teachings of DeFrancesco within the method of Borghesi with the motivation of allowing steps within a process and the order in which these steps are processed to vary (DeFrancesco; col. 2 lines 3-12) thus reducing the cycle time for development and testing of software and reducing the costs in developing software (DeFrancesco; col. 2 lines 12-24)." Applicant respectfully disagrees with this assertion.

The showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular . . .. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. DeFrancesco discloses a workflow management system for credit applications. (DeFrancesco, Abstract). Applicant respectfully submits that the Examiner has not provided a motivation for combining the teachings of Borghesi and DeFrancesco without the benefit of the Applicant's disclosure. Applicant respectfully submits that the Examiner's rejection of claim 1 is based on hindsight speculation not based on the teachings of the prior art.

Applicant submits that, for at least the reasons cited above, claim 1 is patentable over the cited art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). For at least this reason, Applicant submits that the claims dependent from claim 1 are patentable over the cited art.

Amended claim 9 describes a combination of features including:

sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server;

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

Applicant submits, for at least the reasons cited above, that the features of claim 9 are not taught or suggested by Borghesi in view of DeFrancesco. Applicant respectfully requests removal of the rejection of claim 9 and the claims dependent thereon.

Amended claim 16 describes a combination of features including:

sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server;

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

Applicant submits, for at least the reasons cited above, that the features of claim 16 are not taught or suggested by Borghesi in view of DeFrancesco. Applicant respectfully requests removal of the rejection of claim 16 and the claims dependent thereon.

Applicant further submits that many of the dependent claims are independently patentable over the combination of Borghesi and DeFrancesco.

For example, neither Borghesi nor DeFrancesco appear to disclose, teach, or suggest "wherein the insurance claim comprises a bodily injury claim, and wherein the estimate of the value of the insurance claim comprises an estimate of bodily injury general damages" as recited in claim 2. The Examiner states: "Borghesi clearly discloses the insurance claim data file comprising data gathered concerning the extent of damage or injury suffered by the insured, insurance claim settlement information including data on satisfying a claim such as estimates and a total loss calculation for a claim." None of the passages cited by the Examiner, however, teach an estimate of "bodily injury general damages" as recited in claim 2. Applicant asserts claim 2 is

also allowable for at least the above reason.

In addition, neither Borghesi nor DeFrancesco appear to disclose, teach, or suggest "one or more treatments of the bodily injuries" as recited in claim 8. Nonetheless, the Examiner states: "The skilled artisan would have found it an obvious modification to include treatments of bodily injury with the system taught collectively by Borghesi and DeFrancesco with the motivation of efficiently managing an insurance claim work flow by performing, evaluation, and documenting all tasks when processing a claim." The Examiner cites Borghesi, col. 2 lines 20-30 to support the Examiner's statement, but neither the cited passage nor any other portion of Borghesi appears to teach or suggest insurance claim assessment data comprising bodily injuries and treatments of the bodily injuries. The showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular . . .. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. Applicant submits that a person of ordinary skill in the art, at the time of the invention, would not have combined data comprising bodily injuries and treatments of the bodily injuries with the teachings of Borghesi and DeFrancesco without the benefit of the Applicant's disclosure. Applicant respectfully submits that the Examiner's rejection of claim 8 is based on hindsight speculation not based on the teachings of the prior art. Applicant submits claim 8 is also allowable for at least the above reason.

D. Summary

Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

Applicant respectfully requests a one-month extension of time to respond to the Office Action dated June 18, 2004. A fee authorization form in the amount of $110.00 is enclosed for the extension of time fee and added claims fee. If any further extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-36000/EBM.

Respectfully submitted,

Mark R. DeLuca
Reg. No. 44,649

Patent Agent for Applicant

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8800 (voice)
(512) 853-8801 (facsimile)

Date: _____10/18/04_____